REMARKS

In the Office Action dated April 7, 2004, claims 1-18 were presented for examination. Claims 1-2, 4-5, 8-9, and 15-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's admitted prior art (AAPA) in view of *Berg et al.*, U.S. Patent Publication No. 2001/0044904.

Applicant wishes to thank the Examiner for the careful and thorough review and action on the merits in this application.

I.   35 U.S.C. §103(a) – AAPA in view of *Berg et al.*

In the Office Action of April 7, 2004, the Examiner rejected claims 1-2, 4-5, 8-9, and 15-16 under 35 U.S.C. §103(a) as unpatentable over *AAPA* in view of *Berg et al.*, U.S. Publication No. 2001/0044904.

AAPA discloses a prior arc computer system using plexes for storing data between two networked nodes. The *AAPA* clearly shows how multiple copies of data are transferred from the kernel layer to the user layer and from the user layer to the kernel layer. Accordingly, the *AAPA* discloses storing data between or among nodes, but does not support direct communication of the storage data directly from a kernel layer of a source node to a kernel layer of a target node.

The *Berg et al.* publication ('904) discloses a system that supports direct communication of threads on a kernel layer. However, the system of *Berg et al.* does not disclose use associated with storage of data. Rather, *Berg et al.* is used in association with management applications, and more specifically for authentication and/or encryption of communication threads. See Page 3, paragraph [0030]. *Berg et al.* does not teach the use of plexes in association with the communication threads, nor does *Berg et al.* teach or suggest the storage of data associated with such threads. Rather, *Berg et al.* supports communication of threads for authentication and encryption without the need for intervention of the user layer of the operating system.

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Applicant's invention as shown in claims 1-2, 4-5, 8-9, and 15-16 functions on a different principle than that taught in *Berg et al.* Applicant's invention, as supported in the language of the claims, includes the use of plexes in both a source node and a target node at the kernel layer of the operating system of each of the respective nodes. It is this grouping of the plexes that supports efficient storage of data. The plexes and volume(s) of Applicant avoids duplication of storage data at multiple layers of the operating system.

For it to be obvious to combine prior art references, the references must teach, suggest, or motivate one with ordinary skill in the art to combine the references and create the claimed invention. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP §2143.01. The *AAPA* patent does support the use of plexes for direct communication of storage data from a kernel layer of a source node to a kernel layer of a target node. Furthermore, *Berg et al.* does not teach the use of plexes in the kernel layer of the operating system to support the communication of storage data, and in fact does not teach direct communication for storage for any data. Accordingly, neither the *AAPA* nor *Berg et al.* teach or suggest the use of plexes to communicate storage data across the kernel layer of the operation system.

In fact, both *AAPA* and *Berg et al.* fail to address Applicant's use and placement of plexes on both a source node and a target node as a means of achieving improved system performance over that of the prior art. "Although a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." MPEP §2143.01 (citing *In re Mills*, 916 F.2d 680, 682, 16 USPQ 2d. 1430 (Fed. Cir. 1990)). *AAPA* does not suggest modifying the placement of the plexes in either the source or target node to accommodate direct communication of storage data at a kernel layer of the operating system. To read *AAPA* as providing the structure that supports the direct communication of storage data would require a modification to the invention of *AAPA* not envisioned or taught. Furthermore, there is no suggestion found in *Berg et al.* for a modification

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to address multiple plexes and designation of the plexes for specific action, wherein the placement and assignment of the plexes supports direct communication of storage data at a kernel layer of the operating system. The only suggestion for a system that utilizes multiple plexes in both the source node and the target node that supports direct communication of storage data at a kernel layer of the operating system is derived from Applicant's invention. Absent Applicant's invention, there is no suggestion or motivation within the combination of *AAPA* and *Berg et al.* for such a modification. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece togther the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991)). Yet this is the very process that the Examiner has attempted to undertake. Accordingly, the combination of the prior art references is improper as the Examiner's combination is precipitated by utilizing Applicant's claimed invention as the template to make the modifications suggested by the Examiner since such modifications to the prior art would make the prior art nonfunctional — which by its very nature makes such a combination non-obvious.

The teaching, suggestion, or motivation for combining the references must emanate from the references themselves, and not from Applicant. The prior art must teach the desirability of the modification in question. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon et al.*, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984). There is no desire within the references themselves to combine the elements of the prior art to arrive at Applicant's invention. The desirability can be found at best only through the use of Applicant's invention. Therefore, the prior art references whether taken individually or in combination do not render Applicant's invention obvious as there is no teaching, suggestion, or motivation to combine the elements found in different prior art references having different purposes to build the product of Application. Accordingly, Applicants respectfully contend that the combination of *AAPA* and *Berg et al.* does not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests allowance of claims 1-2, 4-5, 8-9, and 15-16.

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Prior Art Made of Record

The prior art made of record by the Examiner and not relied upon, i.c., *Midgley et al.*, U.S. Patent No. 6,704,755, *Fox et al.*, U.S. Patent No. 6,601,186, *Cabrera et al.*, U.S. Patent No. 6,453,325, *Matena et al.*, U.S. Patent No. 6,298,390, *O'Rourke et al.*, U.S. Patent No. 6,212,574, *Mathur et al.*, U.S. Patent No. 5,742,825, *Fowler et al.*, U.S. Patent No. 5,572,709, *Berg*, U.S. Provisional Application No. 60/186,781, *Danahy*, U.S. Provisional Application No. 60/182,743, and *Danahy*, U.S. Provisional Application No. 60/156,671, has been reviewed.

In light of the foregoing amendments and remarks, all of the claims now presented are in condition for allowance, and Applicants respectfully request that the outstanding rejections be withdrawn and this application be passed to issue.

The Examiner is urged to call the undersigned at the number listed below if, in the Examiner's opinion, such a phone conference would aid in furthering the prosecution of this application.

Respectfully submitted,

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The transmission ends with this page

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